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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,723	08/20/2003	Travis T. Hailey JR.	1301-1178	6112

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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/644,723

Applicant(s)

HAILEY, TRAVIS T.

Examiner

William P. Neuder

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 53-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-42,44-49 and 53-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Watson et al 6,575,251.

Watson discloses an inflatable packer 50. The inflatable packer is inflated by a gravel slurry delivered from a surface source. The inflatable element has an interior volume that is to be filled with the gravel slurry. Element 52 has check valves and this element acts as a particulate filter filtering any gravel larger than the check valve openings. A first side of element 52 opens into the interior volume and the second side is disposed towards the gravel slurry source. The inflatable element is filled with the gravel slurry that has been filtered by element 52. As to claim 2, the inflatable element

is moved between a deflated and an inflated state. As to claim 3, the inflatable packer 50 has a top and bottom and a passageway allowing communication of the inflating fluid between the top end and the interior volume. As to claims 4,11,27,32 and 41, the element 52 can be shunt tubes (see col. 7, lines 45-50). As to claims 5,12,28,33 and 42, element 52 is considered an alternative channel. As to claim 6, the element 52 can extend from the top through the packer and out the bottom (figure 6); gravel slurry can be introduced through the bottom end of the element as well. As to claims 7,15,18,30,37 and 38, element 52 includes check valves (col. 7, lines 45-50) that restricts reverse flow. As to claims 8,13,48 and 55, the inflatable packer can be positioned between two sand screen assemblies to isolate the first screen from the second (see col. 2, lines 63-65). As to claims 9 and 14, the inflatable packer can be positioned below a sand screen assembly (see fig. 3). As to claim 10, element 52 has check valves disposed within the passageway that filters the slurry. As to claim 16, a tubular body 54 is present. As to claim 17, the inflatable element has a first segment 64 and a second tubular segment 54. The bladder 56 surrounds second segment 54. Element 52 has check valves disposed within its passageway and the check valves allow the slurry through them while filtering any gravel larger than the check valve opening size. As to claims 19 and 39, the inflatable element is expandable in a radial direction. As to claim 20, bladder 56 is attached to tubular body member 64,54,66. As to claims 21 and 31, end segments 64,66 are connected to tubular body 54. As to claim 22, bladder 56 is connected to the upper 64 and lower 66 end segments. As to claim 23, passageway 52 extends through the upper end into the interior volume (see fig. 5).

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As to claim 24, element 52 can extend through both the upper and lower end segments (see fig. 6). As to claim 25, element 52 enables communication between the exterior of the first segment and the interior volume. As to claim 26, a third lower segment 66 is provided through which element 52 passes (fig. 6) and enables communication between the exterior above first segment 64 and below third segment 66 with the interior volume. As to claim 29, the check valves in element 52 acts as a filter and element 52 is communicably coupled to the expandable bladder. As to claim 40, upon expansion the packer 50 forms a seal between the tubular body and the wellbore wall.

As to claim 34, element 52 has check valves located on it and the check valves act as the filtering means. As to claim 35, element 52 enables communication between the exterior of the first 64 and third 66 segments with the interior bladder. As to claim 36, the check valves are located within element 52 and therefor allows communication with the particulate filter since the check valves act as the particulate filter. As to claim 44, the gravel laden slurry is filtered by element 52 by use of the check valves mounted in the sides. This filtered fluid is then used to expand the packer. As to claim 45, element 52 communicates the inflating fluid between the exterior of the packer and the interior volume. As to claim 46, the check valves restrict reverse flow. As to claim 47, the gravel slurry is also used to gravel pack. As to claim 49, a sand screen completion is present (see fig. 2). As to claim 53, element 52 communicates between the exterior and the interior of the packer. As to claim 54, the gravel slurry is delivered to the packer through element passageway 52.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al (described above) in view of Szarka 4,627,488.

Watson is considered to disclose all of the claimed structure except for the use of a cup packer. Szarka discloses an isolation packer system having cup packers 774,776. It would have been considered obvious to have modified Watson to include a cup packer as taught by Szarka in order to prevent downward flow of fluid thus creating a pressure seal around the packer (col. 13, lines 49-51).


***Response to Arguments***

Applicant's arguments with respect to claims 1-49 and 53-55 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William P Neuder  
Primary Examiner  
Art Unit 3672

W.P.N.